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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,260	04/08/2004	Sarah Bruce Snyder	6298-456	8627
757 7590 05/31/2007 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER MITCHELL, TEENA KAY	
			ART UNIT 3771	PAPER NUMBER
			MAIL DATE 05/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,260	<b>Applicant(s)</b> SNYDER ET AL.	
	<b>Examiner</b> Teena Mitchell	<b>Art Unit</b> 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12, 17, 19-21, 41, 43, 44, 47-51, 53-55 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6-12, 17, 19-21, 59 and 60 is/are allowed.
- 6) ☒ Claim(s) 41, 43, 44, 47-51, 53-55, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/22/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

**Claims 41, 43, 44, 47, 48, 51, 53, 54, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Callaghan (WO 93/11817) in view of Rupprecht et.al. (Medical Device & Diagnostic Industry Magazine- January 1999).**

With respect to claim 41, O'Callaghan in a holding chamber (1) discloses a plastic material having a surface resistivity of between about  $10E10$  and about  $10^{12}$  ohm/sq (O'Callaghan discloses a conductive polyethylene or polypropylene page 4) and inasmuch as Rupprecht teaches that such material is within the claimed range with the specific material used by O'Callaghan it would be obvious to one of ordinary skill in the art at the time the invention was made that the polyethylene or polypropylene would fall within the claimed range as Rupprecht teaches such material with the claimed range (Page 7 under heading Thermoplastics in Common Conductive Compounds and TABLE I of Rupprecht). O'Callaghan does not specifically state that at least a portion of the holding chamber is see-through. However, Rupprecht teaches, "thermoplastic

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compounds retain transparency while exhibiting static-control properties. Particular static-control indices of some thermoplastic polymers, rendering clear or translucent parts. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have at least a portion of the holding chamber of O'Callaghan see-through as such anti-static materials are known to be transparent as taught by Rupprecht.

With respect to claim 43 and 44, note rejection of claim 1 Rupprecht teaches the claimed ranges of surface resistivity (TABLE I).

With respect to claim 47, O'Callaghan discloses an antistatic component (8) separate from said holding chamber (1) connected to said holding chamber. Rupprecht teaches the claimed material having a surface resistivity of between about  $10^E$  and about  $10^{E12}$  ohm/sq.

With respect to claim 48, O'Callaghan discloses said antistatic component comprises a mouthpiece (8) connected to an output end of said holding chamber (1).

With respect to claim 51, O'Callaghan discloses wherein said holding chamber comprises a plastic material (page 4).

With respect to claim 53, Rupprecht teaches the claimed plastic material having a surface resistivity of between about  $10^{E10}$  and about  $10^{E11}$  ohm/sq. (TABLE I).

With respect to claim 54, O'Callaghan discloses wherein the plastic material comprises a polypropylene material (page 4).

With respect to claim 58 O'Callaghan fails to disclose the material selected from the group consisting of a polyurethane elastomer, polyester elastomer, styrenic

elastomer and olefinic elastomer. However Rupprecht teaches the claimed materials used in (TABLE I), therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use the claimed materials as such antistatic materials are taught by Rupprecht and used in medical holding chambers.

**Claims 49, 50, 55, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Callaghan/Rupprecht as applied to claims 1, 9, and 47 above, and further in view of Engelbreth et.al. (6,345,617).**

With respect to claim 49 O'Callaghan does not specifically claim a backpiece (although the MDI does sit into a back area of the holding chamber; note Fig. 1). Engelbreth in an MDI device teaches a backplate (527) providing a means to enable the holding chamber to accommodate actuator boot mouthpieces of various sizes and shapes (Col. 8, lines 41-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the holding chamber of O'Callaghan with a backplate providing a means to enable the holding chamber to accommodate actuator boot mouthpieces of various sizes and shapes including the backplate taught by Engelbreth.

With respect to claim 50, Englebreth teaches wherein the backplate comprises an elastomeric material (Col. 8, lines 41-54).

With respect to claim 55, Englebreth teaches wherein said backplate comprises an opening formed there through (529), said opening shaped and adapted to receive a portion of a pressurized metered dose inhaler.

With respect to claim 57, Englebreth teaches wherein said material comprises an elastomeric material however he does not teach a thermoplastic elastomeric material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a thermoplastic elastomeric material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design consideration. In re Leshin, 227 F.2d 197, 125 USPQ 416.

***Allowable Subject Matter***

Claims 1-4, 612,17, 19-21, 59, and 60 are allowable over the prior art of record.

***Response to Arguments***

Applicant's arguments filed 2/23/07 have been fully considered but they are not persuasive. Applicant argues that the see-through material is hindsight by the examiner.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Note the rejection of claim 41 above and the teaching of Rupprecht.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

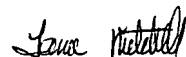
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Teena Mitchell  
Primary Examiner  
Art Unit 3771  
May 17, 2007

TKM  
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